REMARKS

The Examiner provides a number of rejections. We list them here in the order in which they are addressed.

> I.   Claims 1-13 and 17-29 are rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter.

The Applicant responds as follows:

I.   Claims 1-13 and 17-29 are directed to statutory subject matter.

The Examiner has rejected Claims 1-13 and 17-29 under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. The Applicant disagrees.

The Examiner correctly cites *In re Bilski* to demonstrate that the requirements of §101 are satisfied by "imposing meaningful limits" that do not represent "insignificant extra-solution activity":

> "The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. Certain considerations are applicable to analysis under either branch. First, as illustrated by Benson and discussed below, the use of a specific machine or transformation of an article <u>must impose meaningful limits</u> on the claim's scope to impart patent-eligibility. See Benson, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process <u>must not merely be insignificant extra-solution activity</u>. See Flook, 437 U.S. at 590" *In re Bilski, p. 24, lines 3-11.*

Unfortunately, *In re Bilski* explicitly avoids delineating how this two-branched inquiry applies to process claims that recite computers:

> As a result, issues specific to the machine implementation part of the test are not before us today. We leave to future cases the elaboration of the precise contours of machine implementation, as well as the answers to particular questions, such as whether or when recitation of a computer suffices to tie a process claim to a particular machine. *In re Bilski, p. 24, lines 14-18.*

In the absence of controlling case law (or related sources of guidance) evidencing how such "meaningful limits" are appropriately imposed on the scope of process

claim(s), the Applicant looks to the Interim Guidelines released by the USPTO on August 25, 2009. An informative section of these guidelines states:

> For computer implemented processes, the "machine" is often disclosed as a general purpose computer. In these cases, the general purpose computer may be sufficiently "particular" <u>when programmed to perform the process steps</u>. Such programming creates a new machine because a general purpose computer, in effect, becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software. <u>To qualify as a particular machine under the test, the claim must clearly convey that the computer is programmed to perform the steps of the method</u> because such programming, in effect, creates a special purpose computer limited to the use of the particularly claimed combination of elements (i.e., the programmed instructions) performing the particularly claimed combination of functions. If the claim is so abstract and sweeping that performing the process as claimed would cover substantially all practical applications of a judicial exception, such as a mathematical algorithm, the claim would not satisfy the test as the machine would not be sufficiently particular. *USPTO Interim Guidelines, p.6 lines 8-21.*

In regards to independent Claim 1, the Examiner argues: 1) the processor does not appear to be a *specific* machine or apparatus because it is not used to perform the later method steps, and appears to provide third party service software that is not critical to the practice of the invention; and 2) the method does not provide a transformation of matter.

The Applicant respectfully disagrees with both of these assertions. In the absence of an explanation the Applicant still cannot understand how "identifying" and then "resolving" an ambiguity fails to constitute a transformation of matter. Nonetheless, without acquiescing to the Examiner's rejection, but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, the Applicant has amended Claim 1 to clearly indicate that the processor is configured (i.e. programmed) to perform the method steps via the service software.[1] Since Claim 1 satisfies the criteria (outlined by the USPTO Interim Guidelines) by which a "machine" is deemed "sufficiently particular" to satisfy the requirements of §101, the Applicant respectfully requests that the rejection of method Claims 1-13 be withdrawn.

For the reasons cited above, the Applicant further contends that the rejection of Claims 17 should also be withdrawn.

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[1] Such amendments are supported throughout the specification, including for example, page 4 lines 7-12.

In regards to independent Claim 18, the Examiner argues that the method fails to meet any part of the machine or transformation test because 1) the use of a general purpose processor "via the service software" is not a tie to a specific machine or apparatus; and 2) the method does not provide a transformation of matter. The Applicant disagrees.

Concerning the Examiner's second point, the Applicant respectfully resubmits that "identifying" and then "resolving" an ambiguity does represent a sufficient transformation of matter. Nonetheless, without acquiescing to the Examiner's rejection, but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, the Applicant has amended Claim 18 to clearly indicate that the processor is configured (i.e. programmed) to perform the method steps via the service software.[2] Since Claim 18 also satisfies the criteria (outlined by the USPTO Interim Guidelines) by which a "machine" is deemed "sufficiently particular" to satisfy the requirements of §101, the Applicant respectfully requests that the rejection of method Claims 18-24 be withdrawn.

In regards to independent Claim 25, the Examiner argues that the same machine or transformation tests are not met for the reasons provided in Claims 1, 17 and 18. The Applicant disagrees. Nonetheless, without acquiescing to the Examiner's rejection, but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, the Applicant has amended Claim 25 to clearly indicate that the processor is configured (i.e. programmed) to perform the method steps via the service software. For the reasons outlined regarding independent Claims 1 and 18, the Applicant respectfully contends that the rejection of method Claims 25-29[3] should also be withdrawn.

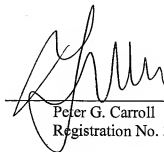[2] Such amendments are supported throughout the specification, including for example, page 4 lines 7-12.
[3] Please note that the present Office Action erroneously excludes Claims 28 and 29 from analysis. A review of Applicant's 10/2/2009 communication clearly reveals New Claims 25-29.

CONCLUSION

     Based on the arguments provided above, the Applicant believes that claims 1-13 and 17-29 are in condition for allowance. Should the Examiner believe a telephone interview would aid in the prosecution of this application, the Applicant encourages the Examiner to call the undersigned at 781.828.9870.

Respectfully submitted,

Dated: _____April 13, 2010_____   _____
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